

Notice of Allowability

Application No.

10/630,587

Examiner

Chih-Min Kam

Applicant(s)

AOKI ET AL.

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/2/06.
2. ☒ The allowed claim(s) is/are 31-35,37 and 38.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 9/15/06
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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DETAILED ACTION

1. The Request for Continued Examination (RCE) filed on October 2, 2006 under 37 CFR 1.114 is acknowledged. An action on the RCE follows.

Status of the Claims

2. Claims 31-35 and 37-38 are pending.

Applicants' amendment filed on October 2, 2006 is acknowledged. Applicants' response has been fully considered. Claims 31 and 38 have been amended, and claim 36 has been cancelled. Thus, claims 31-35 and 37-38 are examined.

Information Disclosure Statement (IDS)

3. The reference by Borodic *et al.* (2001) on the IDS filed September 15, 2006 is not considered because this reference was not submitted. The reference submitted is Borodic *et al.* (Ophthalmic Plastic Reconstructive Surgery 9, 182-190 (1993)).

Withdrawn Claim Objections

4. The previous objection of claim 36 is withdrawn in view of applicants' cancellation of the claim, and applicants' response at page 5 in the amendment filed October 2, 2006.

Withdrawn Claim Rejections - 35 USC § 102

5. The previous rejection of claims 31-35, 37 and 38 under 35 U.S.C. 102(a) as being anticipated by Barwood *et al.* (Developmental Medicine & Child Neurology 42, 116-121 (February 2000)), is withdrawn in view of applicants' amendment to the claim, and applicants' response at page 4 in the amendment filed October 2, 2006.

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Examiner's Amendment

An **Examiner's Amendment** to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Examiner's Amendment to the Specification:

-Please replace the paragraph after the subtitle "CROSS REFERENCE" in the section of "MARKED VERSION OF PAGE ONE OF THE SPECIFICATION" of preliminary amendment filed July 29, 2003 with the following paragraph:

This application is a continuation of U. S. Patent Application serial number 10/199,222, filed July 18, 2002, now U. S. Patent 6,869,610, which is a continuation of U. S. Patent Application serial number 09/550,371, filed April 14, 2000, now U. S. Patent 6,464,986, the entire contents of which prior application and patent are incorporated herein by reference in their entireties.

The following is an Examiner's Statement of Reasons for Allowance: The following references appear to be the closest art to the claimed invention. Aoki *et al.* (U.S. Patent 6,869,610) teach a method for treating pain that occurs after a surgical procedure, the method comprising peripheral administration of an effective amount of a botulinum toxin before, during or immediately after a surgical procedure, wherein the surgical procedure is not carried out to treat a muscle spasm and wherein the surgical procedure is selected from the group consisting of a tumor removal, a bone graft, a bone replacement, an exploratory surgery, a wound closure, a cosmetic surgery, a dermal incision and a non-muscle disorder treatment surgical procedure. Aoki *et al.* (U.S. Patent 6,464,986) teach a method for treating post-operative pain, the method comprising peripheral administration of an effective amount of a botulinum toxin before, during or immediately after a surgical procedure, for a time effective to alleviate a post-operative pain, wherein the pain is not associated with a muscle disorder, and wherein the botulinum toxin comprises a native binding moiety. The terminal disclaimers over these two applications have been filed. Barwood *et al.* (Developmental Medicine & Child Neurology 42, 116-121, February 2000) teach using botulinum toxin A to treat the post-operative pain in children with spastic cerebral palsy (CP), where the pain is often attributed to muscle spasm. However, Barwood *et al.* do not teach using botulinum toxin A to treat a post-operative pain, where the post-operative pain is not associated with a muscle disorder. Therefore, the claims are allowable over the art of record.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Primary Patent Examiner



CHIH-MIN KAM
PRIMARY EXAMINER

CMK

November 10, 2006